

Serial Number: 09/915,982

Docket Number: 10002421-1

REMARKS

Upon entry of this Response, claims 1-30 remain pending in the present application. Claims 6, 8, 15, 17, 24, and 26 have been amended, and claims 28-30 have been added. Applicants request reconsideration of the pending claims in view of the following remarks.

In item 5 of the Office Action, claims 1-27 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,655,130 issued to Dodge et al. (hereafter "Dodge"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow, Applicant requests that the rejection of claims 1-27 be withdrawn.

To begin, claim 1 as originally filed recites as follows:

1. A method for formatting a publication, comprising the steps of:
 - associating a content item with a publication in the server;
 - identifying a presentation platform from a number of potential presentation platforms; and
 - generating an output file in the server including the content item in a digital format recognizable by the presentation platform.

With respect to claim 1, the Office Action states:

"Regarding independent claim 1, Dodge teaches creating documentation, which includes several variations elements of a document, and a computer, such as a server – associating a content item with a publication in the server – (col. 6, lines 42-67, col. 7, lines 1-17, col. 8, line 65-col. 9, line 20). Furthermore, Dodge teaches the generation of an output document from a database, storing the documentation, by filtering or excluding unwanted platform-specific variations of a document from several platform-specific document variations, such as PC, or UNIX paragraphs – identifying a presentation platform from a number of potential presentation platforms – located in the database. The output document contains at least one variation – specific data element, such as PC, or UNIX paragraphs – content item in a format recognizable by the presentation platform --. The filtering or extraction of the output document is done at a file server (col. 6, lines 57-67, col. 7, lines 1-67, col. 8, lines 65-col. 9, line 20, FIG. 2-3)." (Office Action, pages 2-3).

Applicants respectfully disagree. In particular, Applicants assert that the above statement reflects a fundamental misinterpretation of what Dodge fairly

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teaches. Specifically, Dodge teaches the creation of documents that are about different platforms. Specifically, at col. 6, lines 32-43, Dodge states:

"Here is an example of CDS document generation system might be used. Suppose a software product runs on a PC, a UNIX system and a mainframe. The software basically operates the same on all three platforms, but there are significant differences that must be addressed in the user documentation. A typical documentation group would create, generate, and deliver three separate sets of documentation-one for each platform. This is inefficient, redundant, and costly for the documentation group and customers who use the product on two or three of the platforms must use separate, redundant document sets.

Thus, Dodge fails to show or suggest at least the element of identifying a presentation platform from a number of potential presentation platforms upon which to present the publication. In particular, the documents that are generated from the database described by Dodge are all generated on the same type of presentation platform. The user selects the desired content, not the presentation platform upon which the content is to be presented. Thus, it is the content within the documents themselves that varies, not the presentation platform upon which the documents are presented to a user. Thus, the step of identifying a presentation platform from a number of presentation platforms is not shown or suggested by Dodge.

In addition, Dodge does not generate an output file that includes a content item in a digital format recognizable by the presentation platform that was identified from the number of possible presentation platforms. Where this the case, then the documents generated by Dodge, whether they be about a PC, UNIX, or other system could be presented, for example, on a number of different presentation platforms such as a computer screen, printer, personal digital assistant, or other presentation platforms as set forth in the present specification. This is simply not the case. Dodge fails to show or suggest any indication that a document is generated in an output file in any one of a number of presentation platforms so as to be compatible with the selected presentation platform itself.

Thus, Applicant asserts that the rejection of claim 1 is improper. Accordingly, Applicant requests that the rejection of claim 1 be withdrawn. In addition, Applicant requests that the rejection of claims 10 and 19 be withdrawn to the extent that claims 10 and 19 incorporate subject matter similar in scope with that of claim 1. In addition, Applicant requests that the rejection of claims 2-9, 11-18, and 20-27 be withdrawn as depending from claims 1, 10, and 19, respectively.

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In addition, claim 6 has been amended to state as follows:

6. The method of claim 1, wherein the step of generating an output file in the server including the content item in a digital format recognizable by the presentation platform further comprises the steps of:

generating at least one a intermediate file, wherein the content item is associated with the intermediate file; and including the content item; and

transforming the at least one intermediate first file into the output file. a second file, the second file including the content item in the format recognizable by the presentation platform.

With respect to claim 6, the Office Action states:

"Regarding claim 6, which depends on claim 1, Dodge teaches the encapsulation of SGML data elements belonging to four different platform in a source data file – intermediate file including content item. Boxes are checked, which are associated with platform specific documentation (to be used in a computer platform compatible by such documentation, such as a PC, Unix computer, etc.), which caused the filtering out from a database or source file of platform-specific document – transforming a first file into a second file content database from the content item based on the publication identifier – whose check box was not checked (col. 6, lines 32-67, col. 7, lines 1-17, 51-67, col. 11, lines 8-23, 44-67, FIG. 2-3)." (Office Action, page 4).

As set forth in claim 6 as amended, the output file is generated by generating at least one intermediate file where each of the content items is associated with the intermediate file and, then transforming the at least one intermediate file into the output file. In this respect, multiple intermediate files may be created to affect the transformation of a publication for use with a respective presentation platform as set forth in the specification.

Applicant asserts that in neither the cited portions of Dodge above, nor in any other portion of Dodge, is it shown that an intermediate file is created in which the content item is associated therewith, nor is it shown that at least one of the intermediate files is transformed into the ultimate output file that is transmitted to the presentation platform for presentation to a user.

Accordingly, Applicant requests that the rejection of claim 6 be withdrawn. In addition, Applicant requests that the rejection of claims 15 and 24 be withdrawn to the extent that such claims incorporate subject matter similar in scope with that of claim 6. For these additional reasons, Applicant requests that the rejection of claims 8, 17, and 26 be withdrawn as depending from claim 6, 15, and 24.

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Finally, claims 29-30 have been added to further claim various embodiments of the present invention. Favorable action with respect to these claims is requested.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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